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11/20/03
(NE)

Docket No. 450.100

Expedited Processing Requested

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1/20/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Tomokatsu KISHI et al.

Serial No. 09/440,704 Group Art Unit: 2674

Confirmation No. 3313

Filed: November 16, 1999 Examiner: Alexander Eisen

For: PLASMA DISPLAY DRIVING METHOD AND APPARATUS

REQUEST TO WITHDRAWAL FINALITY OF OFFICE ACTION OF JULY 14, 2003 AS PREMATURE, UNDER MPEP 706.07(c)-(e); AND

AMENDMENT UNDER 37 CFR 1.116, UNDER PROTEST

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Attention: Box AF

Sir:

This is in response to the Office Action mailed July 14, 2003, and having a period for response set to expire on October 14, 2003. A Petition for a one-month extension of time, together with the requisite fee for same, is submitted herewith, thereby extending the period for response to November 14, 2003.

The response is accompanied by a Request to Withdrawal Finality, as premature, which is presented first and the response then follows.

The following amendments and remarks are respectfully submitted. Reconsideration of the claims is respectfully requested.

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REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION OF JULY 14, 2003 AS PREMATURE UNDER MPEP 706.07(c)-(e)

It is respectfully submitted that the Action mailed July 14, 2003 is made final prematurely, because of a defective statement of the ground of rejection in item 5 and due to the failure of the Examiner to address the arguments advanced by applicant in the intervening response to the rejections of the first Office Action.

As specified by MPEP 706.07 and 37 CFR 1.113:

> Before final rejection is in order, a clear issue should be developed between the examiner and applicant...
>
> * * *
>
> The examiner should never loose sight of the fact that in every case, the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

These factors are not satisfied in the record of prosecution of the subject application.

More specifically, item 5 of the Action relies on a combination of two references while asserting an anticipation rejection under 35 USC § 102(b). This does not establish a "clear issue."

Further, the Examiner has not addressed the arguments of applicants, presented in the intervening response to traverse the rejections of the first Office Action--contrary to the Examiner's "Response to Arguments" in item 8 of the FINAL Office Action. Specifically, whereas item 8 of the Action at page 6 alleges that applicants' arguments "have been considered but are moot in view of the new ground(s) of rejection"--in fact, the Examiner has not presented <u>any</u> "<u>new</u> grounds of rejection."

Instead, the FINAL Office Action merely presents reorganized sections of the first Office Action. In demonstration of same, attached are annotated copies of the first and second (final) Office Actions, respectively of November 6, 2002 (Exhibit A) and July 14, 2003 (Exhibit B), the former bearing annotations A through I and respective, identical sections of the latter bearing corresponding annotations A' through I'.

Accordingly, the prosecution record reveals that the Examiner has not presented new grounds of rejection but merely presented a reorganized grouping of the previously presented grounds of rejection--while being devoid of any response to applicants' traverses of those previously asserted grounds of rejection.

Applicant has not been given a "full and fair hearing" on the intervening response and the Examiner has failed to develop a "clear issue...before appeal."

Accordingly, withdrawal of the final status of the Office Action for the above reasons is respectfully submitted to be mandated and such action is earnestly solicited. MPEP 706.07(c)-(e).

AMENDMENT UNDER 37 CFR 1.116, UNDER PROTEST

This Amendment is filed in response to the Office Action mailed July 14, 2003, which was made final--but the finality of which is submitted to have been premature and thus this response is under protest relative to that circumstance.

Under the circumstances, moreover, it is submitted that the amendments presented in independent claims 1 and 10 should be entitled to entry as a matter of right and such entry is respectfully requested.